

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-3 and 5-14 are presently pending in this case. Claims 1 and 7 are amended and new Claim 14 is added by the present amendment. As amended Claims 1 and 7 and new Claim 14 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, Claims 1, 2, 5, 7, 8, 10, and 12 were rejected under 35 U.S.C. §103(a) as unpatentable over Fleck et al. (U.S. Patent No. 6,977,811, hereinafter “Fleck”) in view of Goodman et al. (U.S. Patent No. 6,100,875, hereinafter “Goodman”) and further in view of Harada et al. (U.S. Patent No. 6,072,476, hereinafter “Harada”) ; Claims 3 and 9 were rejected 35 U.S.C. §103(a) as unpatentable over Fleck in view of Goodman and Harada and further in view of Boehme et al. (U.S. Patent No. 6,512,670, hereinafter “Boehme”); Claims 6 and 11 were rejected 35 U.S.C. §103(a) as unpatentable over Fleck in view of Goodman and Harada and further in view of Bhatia (U.S. Patent No. 6,288,895); and Claim 13 was rejected 35 U.S.C. §103(a) as unpatentable over Fleck in view of Goodman and Harada and further in view of Nakae et al. (U.S. Patent Application Publication No. 20040166829, hereinafter “Nakae”).

With regard to the rejection of Claims 1 and 7 as unpatentable over Fleck in view of Goodman and further in view of Harada, that rejection is respectfully traversed.

Amended Claim 1 recites in part:

a display;
a main unit provided with a keyboard having a plurality
of operation keys including an enter key;
a pointing device configured to move a pointer
appearing on the display in a desired direction;
a plurality of cursor keys configured to move a cursor
appearing on the display in predetermined directions, the

¹See, e.g., Figure 8.

cursor keys being arranged near the pointing device, ***the cursor and the pointer being different objects***;
a confirmation button configured to confirm an item selected by said pointing device or said cursor keys, the confirmation button being positioned near said cursor keys; and
a switching button configured to rotate a display screen of said display by 90°,
wherein said pointing device, said plurality of cursor keys, and said confirmation button are positioned between said display and said keyboard.

Fleck describes a keyboard with a mouse for handheld portable computer. The outstanding Office Action cited mouse button 300 of Fleck as “a pointing device” and arrow buttons 302-308 of Fleck as “cursor keys.” However, as noted in the Office Action, arrow keys 302-308 do not move a cursor, and cursor movement keys 110-116 of Goodman were cited for this feature. Further, the Advisory Action dated October 23, 2008 indicated that the claimed “pointer” and “cursor” were being read as the same thing.

Goodman describes arrow keys 112-116 that a ***single cursor*** in one of two modes. In the first mode, the arrow keys discretely move the cursor. In the second mode, while pressing the Fn key, the arrow keys continuously move the cursor just like a mouse.² Thus, Goodman explicitly describes moving a ***single cursor*** either discretely or continuously. In a similar manner, Fleck only describes a pointing device for moving a ***single cursor***. Accordingly, the proposed combination would simply provide two different ways to move a ***single cursor***, not “a pointing device configured to move a ***pointer***” ***and*** “a plurality of cursor keys configured to move a ***cursor***... ***the cursor and the pointer being different objects***.” In fact, as Goodman explicitly describes moving a ***single cursor*** either discretely or continuously, Goodman clearly teaches away from having a separate cursor and pointer. Accordingly, the proposed combination does not teach or suggest “a pointing device configured to move a ***pointer***” ***and*** “a plurality of cursor keys configured to move a ***cursor*** ...

²See Goodman, column 3, line 33 to column 4, line 28.

the cursor and the pointer being different objects,” and there can be no suggestion or motivation to combine Fleck and Goodman as proposed.

Further, arrow buttons 302-308 of Fleck move a displayed page while a cursor is fixed on the screen. This allows access to a large page that is being displayed on a small display. As Fleck describes at column 3, lines 18-28, this is only efficient when the arrow buttons are located around the mouse button. Thus, the proposed modification, replacing the arrow keys 302-308 of Fleck with cursor movement keys 110-116 of Goodman would make the device of Fleck unsuitable for its intended purpose. As described in MPEP §2143.01, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, without arrow buttons 302-308, the device of Fleck cannot scroll across a page so that a user can eventually see the entire page on the small display. Therefore, the miniaturized device of Fleck needs arrow buttons 302-308 to access the entire screen. By replacing these arrow buttons with additional buttons for moving the cursor, the proposed combination makes the device of Fleck unsuitable for its intended purpose, which is to provide a compact device with an efficient way of displaying and selecting information. Accordingly, there can be no suggestion or motivation to combine Fleck and Goodman as proposed.

With regard to this argument, the outstanding Office Action asserts that “as is well-known in the art, the cursor will proceed to the next page if a user continuously holds down an arrow key.”³ To the extent that this statement asserts that this characteristic is inherent in either of Fleck or Goodman, no evidence or reasoning has been provided to prove that this characteristic is ***necessarily*** part of either reference, contrary to well settled case law. For example, “[T]o establish inherency, ***the extrinsic evidence ‘must make clear that the missing***

³See the outstanding Office Action at page 10, lines 20-21.

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (Emphasis added.). Accordingly, a proper inherency rejection has not been made.

In fact, it is respectfully submitted that mouse button 300 of Fleck does not inherently proceed to the next page if a user continuously holds down mouse button 300, because if it did, arrow keys 302-308 would be not be needed to scroll the screen. Thus, as the assumption made by the outstanding Office Action would render arrow keys 302-308 of Fleck unnecessary, it is respectfully submitted that this assumption is not necessarily true. Therefore, it is respectfully submitted that arrow keys 302-308 of Fleck have a different function than cursor movement keys 110-116 of Goodman, and replacing arrow keys 302-308 of Fleck have a different function than cursor movement keys 110-116 of Goodman would make Fleck unsuitable for its intended purpose, as noted above.

Consequently, amended Claim 1 (and Claims 2, 3, 5, 6, and 12-14 dependent therefrom) is patentable over the cited references.

In a similar manner, amended Claim 7 (and Claims 8-11 dependent therefrom) is also patentable over the cited references, as the proposed combination does not teach or suggest both “pointing means” and “cursor moving means” as defined in amended Claim 7, and there is no suggestion motivation to combine Fleck and Goodman as proposed.

With regard to the rejection of Claims 3 and 9 as unpatentable over Fleck in view of Goodman and Harada and further in view of Boehme, it is noted that Claims 3 and 9 are dependent from Claims 1 and 7, respectively, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Boehme does not

cure any of the above-noted deficiencies of Fleck, Goodman, and Harada. Accordingly, it is respectfully submitted that Claims 3 and 9 are patentable over Fleck in view of Goodman and Harada and further in view of Boehme.

With regard to the rejection of Claims 6 and 11 as unpatentable over Fleck in view of Goodman and Harada and further in view of Bhatia, it is noted that Claims 6 and 11 are dependent from Claims 1 and 7, respectively, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Bhatia does not cure any of the above-noted deficiencies of Fleck, Goodman, and Harada. Accordingly, it is respectfully submitted that Claims 6 and 11 are patentable over Fleck in view of Goodman and Harada and further in view of Bhatia.

With regard to the rejection of Claim 13 as unpatentable over Fleck in view of Goodman and Harada and further in view of Nakae, it is noted that Claim 13 is dependent from Claim 1, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Nakae does not cure any of the above-noted deficiencies of Fleck, Goodman, and Harada. Accordingly, it is respectfully submitted that Claim 13 is patentable over Fleck in view of Goodman and Harada and further in view of Nakae.

New Claim 14 is supported at least by Figure 8. New Claim 14 is dependent on Claim 1, and thus is believed to be patentable for at least the reasons described above with respect to Claim 1. In addition, Claim 14 recites subject matter that further patentably defines over Fleck, Goodman, and Harada. Consequently, new Claim 14 is also patentable over Fleck in view of Goodman and Harada.

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Accordingly, the pending claims are believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Bradley D. Lytle", is written over a horizontal line.

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